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REMARKS

Claims 1 through 18 are pending in the Application.

Claims 1 through 18 have been rejected.

Examiner has rejected claims 1 through 18 under 35 U.S.C. § 103 (a) as being unpatentable over USPN 5,717,941 (Yoshida) in view of USPN 6,686,930 (Powers).

Applicant traverses the rejection and respectfully requests reconsideration.

Criteria for a Rejection under 35 U.S.C. § 103(a)

Obviousness under 35 U.S.C. § 103 is a question of law based on the following factual inquiries: (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; (3) the level of ordinary skill in the art; and (4) objective evidence of secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 567 (1966).

A *prima facie* case of obviousness must be based on properly ascertaining the scope and content of the prior art and recognizing the differences between the prior art and the claims at issue. See, for example, the USPTO explanation of the use of the test in *Graham v. John Deere Co.* for the establishment of a *prima facie* case of obviousness as set out in MPEP 2143. Examiner's rationale for the rejection under 35 U.S.C. § 103 has failed to properly carry out the first two factual inquiries set out by *Graham v. John Deere Co.* and thus has failed to lay the proper foundation for a *prima facie* case of obviousness. The Examiner's failure to articulate the difference between the prior art and the claims at issue has resulted in a failure to present an analysis that supports a finding of obviousness

Below, Applicant points out the differences between the prior art and the subject matter set out in each of the independent claims. The Applicant further sets out reasons why the subject matter set out in the independent claims is not obvious over what is disclosed in the prior art.

### Discussion of Independent Claim 1

Independent claim 1 sets out a method of scanning multi-sided documents. In claim 1, a TWAIN source is used to control scanning of multiple sides of a multi-sided document by a scanning device. The TWAIN source produces a composite image by tiling the images of individual sides of the multi-sided document vertically, horizontally, or a combination of vertical and horizontal placements. A TWAIN protocol is used to transfer the composite image from the TWAIN source to an application running on a computing device. This is not disclosed or suggested by the cited art.

Examiner has asserted that Yoshida discloses use of a TWAIN source to control scanning of multiple sides of a multi-sided document by a scanning device. See the Office Action dated June 10, 2008, at page 4. This is factually incorrect. Yoshida does not disclose or suggest a TWAIN source or any use of a TWAIN source. Yoshida, therefore, presents no information relevant to the innovative way that a TWAIN source is used to produce a composite image as set out in claim 1 of the present case.

Powers is representative of the prior art most relevant to the subject matter set out in claim 1. In Powers, an image processing application controls creation of a destination image. A TWAIN source transfers a source image that is an image of only one side of a document. See Powers at column 6, line 10 through 45. After the application 514 receives the scan information from the TWAIN source, the application 514 makes the information available to the paster 542 which then combines the information with the destination image information where it is presented to a user. See column 10, line 59 through column 11, line 4. As seen from Figure 5, paster 542 resides in the image processing application 514, not the TWAIN image source 518.

Powers is relevant to the subject matter of claim 1 in that Powers discloses a TWAIN source and Powers discloses how images from a TWAIN source are handled and combined by an image processing application. That is, as shown by

Figure 5 of Powers, the image processing application is used to stitch images together.

Powers differs from the subject matter set out in claim 1 in that Powers teaches that any processing of images (e.g., such as producing a composite image by tiling the images of individual sides of the multi-sided document vertically, horizontally, or a combination of vertical and horizontal placements) are handled by the image processing application, not by a TWAIN source. This is what is done in the prior art, and this is what is improved by the subject matter of claim 1.

In order to present a *prima facie* case of obviousness, the Examiner must present a convincing line of reasoning as to why a person of ordinary skill in the art would find this modification to be obvious. Examiner has failed to do so.

Further, there are many reasons why modification to Powers would not be obvious.

For example, a prior patent must be considered in its entirety (i.e., as a whole), including portions that would lead away from the invention in issue. *Panduit Corp. v. Dennison Manufacturing Co.*, 810 F.2d 1561, 1 U.S.P.Q.2d 1593 (Fed Cir. 1987). It is impermissible within the framework of 35 U.S.C. § 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 230 U.S.P.Q. 416 (Fed Cir. 1986).

That is, the courts have indicated that consideration must be given to prior art that would lead one away from the invention as well as that which is argued to lead toward it. *Mendenhall v. Astec Industries, Inc.*, 13 U.S.P.Q.2d 1913, 1939 (Tenn. 1988), *aff'd*, 13 U.S.P.Q.2d 1956 (Fed Cir. 1989). The fact that the prior art contains numerous negative teachings, which would have discouraged and deterred a person having ordinary skill in the art from making the inventions of the patents in suit, is further evidence of non-obviousness. *Mobil Oil Corp. v. W. R. Grace & Co.*, 367 F. Supp. 207, 180 U.S.P.Q. 418, 452 (Conn. 1973).

In this case, Powers very clearly discloses that any processing of images is handled by the image processing application, not by a TWAIN source. This is typical in the prior art.

The subject matter of claim 1 takes an entirely different approach, moving this functionality into TWAIN source. This is against the common practice and teaching in the prior art. Nowhere in the prior art is this radical departure from current practice disclosed or suggested. There is nothing in the prior art that would suggest this to a practitioner in the art or motivate a practitioner in the art to make this change.

The motivation to make a specific structure is not abstract, but practical, and is always related to the properties or uses on skilled in the art would expect the structure to have, if made. The critical inquiry is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *In re Newell*, 891 F.2d 899, 13 U.S.P.Q.2d 1248, 1250 (Fed. Cir. 1989).

The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims is not, by itself, sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of the applicant's specification, to make the necessary changes in the reference device. *Ex parte Chicago Rawhide Manufacturing Co.*, 226 U.S.P.Q 438 (PTO Bd. App. 1984).

There is nothing in the prior art that suggests the desirability and thus provides motivation to a person of ordinary skill in the art to modify Powers (or other prior art like Powers) to move functionality found in an imaging processing application into a TWAIN source. The teaching to do so is a unique and non-obvious feature of the subject matter set out in claim 1.

### Discussion of Independent Claim 7

Independent claim 7 sets out a method of scanning multi-sided documents.

In claim 7, a TWAIN source is used to control scanning of multiple sides of a multi-sided document by a scanning device. A single composite image for the multi-sided document is transferred from the TWAIN source to a TWAIN application. The single composite image is composed of vertically tiled images. Each of the vertically tiled images is an image of one side of the multi-sided document. This is not disclosed or suggested by the cited art.

As discussed above, Yoshida does not disclose or suggest a TWAIN source or any use of a TWAIN source, and thus is not really relevant to the subject matter set out in claim 7.

Powers is representative of the prior art in that Powers discloses a TWAIN source, but does not disclose or suggest that a TWAIN source produces a composite image by tiling the images of individual sides of a multi-sided document. Instead, in Powers as in similar prior art, an image processing application controls creation of the destination image. In Powers, the TWAIN source transfers a source image which is an image of only one side of a document. See, column 6, line 10 through 45. After the application 514 receives the scan information from the TWAIN source, the application 514 makes the information available to the paster 542 which then combines the information with the destination image information where it is presented to a user. See column 10, line 59 through column 11, line 4. As seen from Figure 5, paster 542 resides in the image processing application 514, not the TWAIN image source 518.

In the prior art, as represented by Figure 5 of Powers, the image processing application is used to stitch images together. This is a teaching away from the innovative and non-obvious feature of the subject matter of claim 7 where a TWAIN source produces a composite image. Examiner has failed to show how the prior art provides any motivation, outside of impermissible hindsight based on Applicant's Specification, to make such a modification to Powers.

**Discussion of Independent Claim 13**

Independent claim 13 sets out a method of scanning documents. In claim 7, a TWAIN source user interface is displayed. The TWAIN source user interface allows a user to select scanning of a multi-sided document. This is not disclosed or suggested by the cited art.

As discussed above Yoshida does not disclose or suggest a TWAIN source or any use of a TWAIN source user interface, and thus is not really relevant to the subject matter set out in claim 13.

Powers does not disclose or suggest that a TWAIN source user interface allows a user to select scanning of a multi-sided document.

Claim 13 also indicates that when scanning of a multi-sided document is selected by the user, the TWAIN source creates a single composite image that includes images of all sides of the multi-sided document. The TWAIN source forwards the single composite image from the TWAIN source to an application running on a computing. This is not disclosed or suggested by the prior art.

As discussed above, Powers is representative of the prior art in that Powers discloses a TWAIN source, but does not disclose or suggest that a TWAIN source creates a single composite image that includes images of all sides of the multi-sided document.

As discussed above, in Powers, an image processing application controls creation of the destination image. In Powers, the TWAIN source transfers a source image which is an image of only one side of a document. See, column 6, line 10 through 45. After the application 514 receives the scan information from the TWAIN source, the application 514 makes the information available to the poster 542 which then combines the information with the destination image information where it is presented to a user. See column 10, line 59 through column 11, line 4.

As seen from Figure 5, paster 542 resides in the image processing application 514, not the TWAIN image source 518.

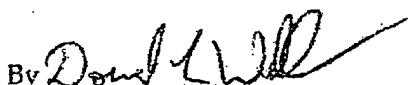
In the prior art, as represented by Figure 5 of Powers, the image processing application is used to stitch images together. This is a teaching away from the innovative and non-obvious feature of the subject matter of claim 7 where a TWAIN source creates a single composite image that includes images of all sides of the multi-sided document. Examiner has failed to show how the prior art provides any motivation, outside of impermissible hindsight based on Applicant's Specification, to make such a modification to Powers.

#### Conclusion

Applicant believes the present application is in condition for allowance and favorable action is respectfully requested.

Respectfully submitted,

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